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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NOVOSAD, JENNIFER ELEANORE

ART UNIT PAPER NUMBER

3634

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,598

Applicant(s)

PIPPIN ET AL.

Examiner

Jennifer E. Novosad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/27/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Drawings***

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because it appears that Figures 2, 23, and 28 are drawn incorrectly. In particular, it appears that the bags should be drawn using hidden lines. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Abstract

Applicant is reminded of the proper content of an abstract of the disclosure. The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art, such as "unique" in line 2, "set up quickly" in line 3 and "This eliminates the... in delivery efficiency" in lines 5-8.

The abstract of the disclosure is objected to because "includes facilitates" in line 1 appears to be grammatically incorrect. Correction is required. See MPEP § 608.01(b).

Specification

The disclosure is objected to because of the following informalities:

In line 5 of page 1 (as numbered by applicant), "August 7, 2001" should be changed to --November 26, 2001, now U.S. Patent No. 6,715,614--. It is noted that the "effective date" of August 7, 2001 is not the same as the "filing date" of November 26, 2001. Appropriate correction is required.

The use of the trademark "Post-It" (see page 12, line 9) has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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Claim Objections

Claim 2 is objected to because in line 2, it appears that --than-- should be inserted after "greater". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 5-11, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The functional recitation "are of dimensions suitable for receiving mail pieces therein" in claim 2 renders the claim indefinite since mail pieces are not being positively claimed, it is unclear what dimension is "suitable". *For example*, it is noted that a computer shipped through the mail can be considered as a mail piece and a letter shipped through the mail is also considered to be a mail piece, but one can see that these two examples have dimensions that are vastly different from one another. *Thus*, the metes and bounds of the claim cannot be properly ascertained since it is unclear what dimensions are "suitable".

Claim 3 recites the limitation "the top corners of the device" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is noted that the structure of the device, other than the bags, has not been properly defined.

Claim 5 recites the limitation "the strips" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is noted that claim 1 sets forth "a", i.e., singular, strip.

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Claim 6 is rendered indefinite since it is unclear what defines a "common" case.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: between the case and rails.

The language of the recitation "a plurality of multi-bags" in line 2 of claim 8 appears to be grammatically incorrect thereby rendering the claim indefinite since it is unclear what structure defines this element. It appears that perhaps a word is missing after "multi-bags". Note also line 1 of claims 11-18.

Claim 8 is rendered indefinite since the preamble does not set forth the proper structure, i.e., the preamble recites a "case" and then line 6 sets forth that the "case" of line 1 comprises "a case". *To correct this*, it appears that a word, such as --assembly--, should be inserted after "case" in line 1 of claim 8. Also note claims 9 and 10, i.e., it is unclear in claims 9 and 10, which "case" is being referenced in the recitation "wherein the case".

Claim 8 recites the limitations (a) "the device" in line 5 and (b) "the storage devices" in line 6 (note also line 2 of claim 9). There is insufficient antecedent basis for these limitations in the claims.

The recitation "when unfilled and stretched to a taut condition" in line 4 of claim 11 renders the claim indefinite. *In particular*, it is unclear what structure is "stretched" and what defines "unfilled". *Further*, the language of claim 11 is awkward thereby making it unclear what is being set forth. *Namely*, it appears contradictory to recite that the "strips unite the multi-bag" (see line 7) when the strips actually unite the "walled bags". *Finally*, the limitation "sufficient

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strength" (in line 8 of claim 11 and claim 16) is vague and/or indefinite since it is unclear what defines "sufficient". It is noted that claim 16 is rendered indefinite since the claim fails to further limit the positively claimed structure of the multi-bag and in fact, the exact recitation of claim 16 is found in the last two lines of claim 11.

Claim 14 recites the limitation "the tabs" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is noted that claim 13 sets forth "tabs", not claim 11. Thus, the structural relationship between the elements is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 11, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,815,903 (Foster *et al.* '903).

Foster *et al.* '903 disclose a storage device (for example, see Figure 24) comprising a series of flexible (see column 2, line 45) walled bags (516) disposed side by side such that the mouths of the bags face a common direction and the bags being united by a reinforcing strip (532) extending along a lengthwise direction of the device on each side thereof; the depth and length of each bag being greater than the width thereof; the edges of each bag are integrally bonded to the edges of adjoining bags (see Figure 18); the strips (532) have means (536 and 534) for removably securing the device to a supporting frame (not shown - see column 11, lines 9-13)

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so that the mouths of the bags remain open; *with respect to claim 15*, see Figure 14 which shows projections (618) and slots (652).

Claims 1-7, 8-10, 11, 16-18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 1,755,950 (Dobson *et al.* '950).

Dobson *et al.* '950 disclose a mail bag assembly comprising a plurality of multi-bags (top half of Figure 4 is one and bottom half of Figure 4 is a second one) each comprising a series (left to right in Figure 3) of flexible walled bags (42) disposed side by side such that the mouths of the bags face a common direction, i.e., forward, and form a row (see Figure 1) wherein the bags are united by a pair of reinforcing strips (a first pair is 48, see Figure 3) extending in a lengthwise (left to right) direction of the bags; a case (the truck) having means (the bottom surface of the truck) for mounting the bags; the bags having a mechanism (33, 31) for tensioning the bags to hold the mouths open (see Figure 4) and for relaxing (see Figures 7 and 8) the bags; the case (i.e., the truck) comprising spaced horizontal rails (the side walls of the truck) and the bags are removably mounted one above the other (see Figure 4) in openings *between* the rails; and a bag locking mechanism (16) which releasably engage the strips (48) while the tensioning mechanism (31, 33) tensions the bags; the strips having means (18, 26) thereon for removably securing the device to a supporting frame (27); and mail inserted into each bag which is labeled (44) through a common delivery point.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '903 as applied to claims 1-5, 11, 15, and 16 above, and further in view of U.S. Patent No. 4,765,490 (Hanson '490).

Foster *et al.* '903 disclose the device as advanced above.

The claims differ Foster *et al.* '903 in requiring a plurality of devices mounted in a case (claim 6) one above another on spaced horizontal rails (claim 7).

Hanson '490 teaches a case (C) having spaced apart horizontal rails (3) whereby storage devices (F) are mounted in the case, on the rails and above one another.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed a plurality of devices as shown by Foster *et al.* '903 in a case, as taught by Hanson '490, for increased storage capabilities and capacity.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dobson *et al.* '950, alone.

Dobson *et al.* '950 disclose the assembly as advanced above.

The claim differs from Dobson *et al.* '950 in requiring the bags to be made from high density polyethylene having a specific thickness.

Although Dobson *et al.* '950 are silent as to the material used and the thickness thereof, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have fabricated the bags from the specified material and thickness, for ease in economy and manufacture.

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Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '903, alone.

Foster *et al.* '903 disclose the assembly as advanced above.

The claims differ from Foster *et al.* '903 in requiring the bags to be made from high density polyethylene having a specific thickness.

Although Foster *et al.* '903 are silent as to the material used and the thickness thereof, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have fabricated the bags from the specified material and thickness, for ease in economy and manufacture.

Insomuch as the claim is best understood (in view of the Section 112 rejection advanced above, i.e., lack of antecedent basis), claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '903 as applied to claims 1-5, 11, 15, and 16 above, and further in view of U.S. Patent No. 4,219,247 (Litchfield *et al.* '247).

Foster *et al.* '903 disclose the assembly as advanced above.

The claim differs from Foster *et al.* '903 in requiring the attaching means to define adhesive.

Litchfield *et al.* '247 teach the use of adhesive.

Thus, it would have been an obvious design choice to one of ordinary skill in the art at the time the invention was made to have utilized adhesive as an attaching means for ease in economy, manufacture, and assembly.

Allowable Subject Matter

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to show or suggest a multi-bag, as in claim 11, wherein the strips have a series of tabs and notches along an edge thereof so that one tab extends into the mouth of each bag, as specifically called for in the claimed combination of claim 13.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703)-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

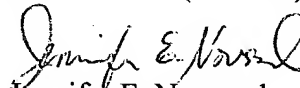
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer E. Novosad
Examiner
Art Unit 3634

Jennifer E. Novosad/jen
July 21, 2004